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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER				
D AGOSTA, STEPHEN M				
ART UNIT		PAPER NUMBER		
2683				

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,536

Applicant(s)

TASTO, MANFRED

Examiner

Stephen M. D'Agosta

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 11-25 have been considered but are moot in view of the new ground(s) of rejection.

1. The amendment overcomes the examiner's prior claim objections.
2. The new IDS has been signed.
3. A new rejection is provided below based on the amendment (note: the pico cell is not part of the public cellular network).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-13, 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zicker et al. US 5,887,259 and further in view of Alperovich US 6,233,448.

As per **claims 11, 17 and 19**, Zicker teaches teaches a method for operating a mobile communication device in a public cellular network having plurality of radio cells, at least one BTS and one mobile station (abstract, figure 1), comprising:

Designating the at least one MOBILE as a subscriber in the mobile radio network (abstract, figures 1 and 5),

Logging the mobile station off from the BTS station when a first message from a locally emitting transmitter of small capacity is received, said locally emitting transmitter being part of a pico-cell network separate from the public cellular network, (abstract and C3, L1-7: "...The system uses handsets which automatically switch between a standard

cellular radiotelephone mode of operation and an enhanced cordless mode when the handsets are within range of pico cells that are interconnected to the public switched telephone network. Each pico cell is controlled via a framework of overlay cells that operates independently of the radiotelephone network and uses a unique control protocol on a small number of reserved cellular channels. Each pico cell consists of a spectrally dynamic, non-capturing, frequency agile, multi-purpose base station provided at customer-selected locations to cooperate with the overlay cell framework. Each pico cell reduces traffic on the standard cellular radiotelephone network by independently handling registered handsets....". The examiner notes that "handshaking" is inherently required when the mobile switches between networks which reads on a message being sent (eg. a registration message).

But is silent on li a radio cell, selecting on of: deactivating the mobile, stopping the mobile station, or passing the mobile station over either into an inactive call-blocked mode or into a mode that is blocked for outgoing calls, and

Reactivating the at least one mobile when a second message is received from the locally emitting transmitter

Alperovich teaches a system that activates/deactivates a mobile device based upon the position/location of said device (abstract). Hence the system inherently must deactivate and reactivate the mobile if/when it roams into a "denial area".

It would have been obvious to one skilled in the art at the time of the invention to modify Oura, such that the mobile is deactivated/stopped/call-blocked and then reactivated via a second message, to provide means for the cellular/pico networks to send activation/deactivation controls to a mobile depending upon where they roam.

As per **claim 12**, Zicker teaches claim 11 **but is silent on** further comprising the step of manually activating and logging the mobile station onto the mobile radio network given a lack of a second message when the transmission range of the locally emitting transmitter is exceeded.

Alperovich teaches a system that activates/deactivates a mobile device based upon the position/location of said device (abstract).

It would have been obvious to one skilled in the art at the time of the invention to modify Zicker, such that the mobile is manually logged onto the network when the picocell transmission range is exceeded, to provide means for the user to reactivate the phone when out of denied service area.

As per **claim 13**, Zicker teaches claim 11 **but is silent on** further comprising the step of automatically passing the mobile station over to an active mode and accepting standby operation when the second message is not received after a prescribable time interval.

Alperovich teaches a system that automatically activates/deactivates a mobile device based upon the position/location of said device (abstract). This system periodically checks the location of the user.

It would have been obvious to one skilled in the art at the time of the invention to modify Zicker, such that the mobile is passed over to active mode and accepting standby operations when second message is not received after some time, to provide means for the unit to automatically comeback online after a certain amount of time has passed whereby the user may have moved outside the denied service area zone.

As per **claims 16 and 18**, Zicker teaches claim 11/17 wherein a mobile telephone is a subscriber in the radio network (abstract and figures 1 and 5).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zicker/Alperovich and further in view of Takemura EP0830046.

As per **claim 14**, Zicker teaches claim 13 **but is silent on** further comprising the step of displaying the message content and/or a message parameter.

Takemura teaches transmission restriction of a mobile phone (title) whereby the mobile displays an indication for notifying that is has been placed in disabled mode (C4, L33-43).

It would have been obvious to one skilled in the art at the time of the invention to modify Zicker, such that a message or message parameter is displayed, to provide means for the user to be able to read a message stating service is denied.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zicker/Alperovich/Takemura and further in view of Davis et al. US 6,314,519.

As per **claim 15**, Zicker teaches claim 14 **but is silent on** further comprising the step of signaling reception of either the first message or the second message by one of optical or acoustic means.

Davis teaches "A fourth aspect of the invention involves the subscriber unit or pager being equipped with a primary and possibly a secondary apparatus for communicating both inbound and outbound messages. The primary apparatus comprises a conventional radio frequency receiver and optionally a conventional radio frequency transmitter. The secondary apparatus comprises an optical receiver and optionally an optical transmitter. Alternatively, the secondary apparatus may further comprise one or more acoustic or other electromagnetic transducers and associated circuitry implementing a uni- or bi-directional communication link between the subscriber unit or pager and the originator" (C2, L32-42).

It would have been obvious to one skilled in the art at the time of the invention to modify Zicker, such that optical or acoustic means are used, to provide for multiple communication technologies to be used between BTS, picocell and mobile.

Claim 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zicker/Alperovich and further in view of Oura.

As per **claim 20**, Zicker teaches claim 19 **but is silent on** wherein the picocell transmitter is arranged in doorways or on aircraft runways.

Oura teaches (C1, L5-17) using an activation/deactivation system in airplanes, hospitals and public places which can be placed in doorways, rooms, etc.).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Zicker, such that the picocell transmitter is arranged in doorways or on aircraft runways, to provide means for limiting mobile device usage in certain areas which are deemed "denial areas".

Claims 22-23 rejected under 35 U.S.C. 103(a) as being unpatentable over Zicker/Alperovich and further in view of Mousseau et al. 2002/0194285 (CIP date is 5-29-98) and Matero US 5,974,305.

As per **claim 22**, Zicker teaches claim 21 **but is silent on** wherein the picocell radio system is a DECT Standard or blue-tooth standard.

Mousseau teaches redirecting user-selected messages such as e-mail messages, calendar events, meeting notifications, address entries, alarms, warnings, stock quotes, news bulletins, journal entries and personal reminders, including attachments such as word processing document, video and audio clips, from host system such as user's desktop system and network server to Bluetooth enabled mobile communication devices such as mobile telephone, wirelessly enabled laptop and palmtop computers and handheld two-way wireless paging computer through LAN, WAN, Internet, wireless, cable TV and satellite networks (page 10, claim 6). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Zicker, such that Bluetooth is used, to provide RF wireless support between devices using an industry-wide standard.

For DECT, Matero discloses support for dual mode operation, i.e., digital TDMA and analog FM, also referred to as DAMPS. In an article entitled "GSM and DECT-A Dual Mode Solution", Mobile Communications International Apr. 21, 1995, pgs. 57-60, B. Rashidzadel et al. describe an RF subsystem in FIG. 3 for a dual mode handset that operates in the GSM frequency band (890-960 MHz) and the DECT frequency band (1880-1900 MHz) [C1, L10-50]. It would have been obvious to one skilled in the art at the time of the invention to modify Zicker, such that DECT communications is supported, to provide means for multiple standards to be used for communications between BTS, picocell and mobile.

As per **claim 23**, Zicker teaches claim 22 wherein a mobile telephone is a subscriber in the radio network (abstract and figures 1 and 5).

Claims 24-25 rejected under 35 U.S.C. 103(a) as being unpatentable over Zicker/Alperovich and further in view of Matero.

As per **claims 24-25**, Zicker teaches claim 23/24 **but is silent on** wherein the mobile phone is a dual-mode phone or DECT/GSM phone.

Matero teaches in the United States of America there is presently at least one system which supports dual mode operation, i.e., digital TDMA and analog FM, also referred to as DAMPS. As the systems such as GSM, PCS, DECT, DCS1800 and TDMA1900 become more widely used there is expected to be a need to have mobile stations which support two modes of operation, such as GSM and DCS1800 or DAMPS and TDMA1900 or DCS1900. A proposed third generation mobile telecommunication systems, such as UMTS (in ETSI) or FPLMTS (in CCIR), is under development. These advanced systems may also require some type of dual mode operation. In an article entitled "GSM and DECT-A Dual Mode Solution", Mobile Communications International Apr. 21, 1995, pgs. 57-60, B. Rashidzadel et al. describe an RF subsystem in FIG. 3 for a dual mode handset that operates in the GSM frequency band (890-960 MHz) and the DECT frequency band (1880-1900 MHz). In the transmitter portion a single I/Q modulator provides direct modulation at either the DECT or GSM frequency bands, and is connected through a SPDT switch to one of a DECT or a GSM transmitter chain. In the receiver portion separate DECT and GSM low noise amplifiers (LNAs) are used due to the large difference in frequencies (C1, L10-50).

It would have been obvious to one skilled in the art at the time of the invention to modify Zicker, such that DECT/GSM is supported, to provide means for multiple standards to be used for communication between BTS, picocell and mobile.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).